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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/814,969 | 03/31/2004 | Sergey M. Shevchenko | 7759 | 8693 |
| 49459 | 7590 | 08/16/2006 | EXAMINER | |
| NALCO COMPANY 1601 W. DIEHL ROAD NAPERVILLE, IL 60563-1198 | | | WU, IVES J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1724 | |
| DATE MAILED: 08/16/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,969

Applicant(s)

SHEVCHENKO ET AL.

Examiner

Ives Wu

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 15 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1). Applicants' Request-for-Continued-Examination (RCE) filed on July 7, 2006 and Amendments filed on June 15, 2006 have been received and acknowledged.

Claims 1-13 are cancelled previously.

An Action follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(2). **Claims 14, 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Baehr et al (US004880566).

As to the water content in the composition of **independent claim 14**, Baehr et al (US004880566) disclose as cited: Based on the quantities of aqueous 35 wt % hydrogen peroxide solution used, the stabilizer mixtures according to the invention are used in concentrations of from 2 to 25 % active substance, Col. 3, line 4-8. In other words, the water content is calculated and ranged from 40 % to 63 % wt.

As to the polyacrylic acid content in the composition of independent claim 14, Baehr et al (US004880566) disclose as cited: From 1 to 5 wt % of component B which is polyacrylic acid, Col. 2, line 32.

As to the diethylenetriaminepentakis(methyl)phosphonic acid, its salt content in the composition of **independent claim 14**, Baehr et al (US004880566) disclose as cited: Component C polyamine- and/or amine polyphosphonic acid acids, Col. 2, line 25-26; Particularly suitable polyamide and/or amine polyphosphonic acids, if desired in the form of their alkali metal and/or ammonium salts, are diethylenetriamine penta-(methylenephosphonic acid) DTPMP, Col. 2, line 44-48; from 2 to 20 wt % of component ©, Col. 2, line 32-33.

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As to inert compound content in the composition of independent claim 14, Baehr et al (US004880566) disclose 5 g sodium persulfate in examples 1 and 2, its content is 2 wt% and 4 wt%, Col. 3-4.

As to synergistic mixture for enhancing the brightness of bleached pulp in **independent claim 14**, the disclosure of prior art reference Baehr meets the requirements of the present claim both in terms of the types of materials added and their contents. It is reasonable to presume that the mixture of Baehr would fulfill the same utility as synergistic mixture for enhancing the brightness of bleached pulp as presently claimed in light of its chemical similarities. The burden is shifted to applicants to establish that the mixture of present claim is not the same as or obvious as that mixture set forth by the reference.

(3). The same rationale of rejection for **claim 16** is recited in the prior Office Action dated March 15, 2006.

Claim Rejections - 35 USC § 103

(4). The text of those sections of Title 35, U. S. Code not included in this Office Action can be found in the prior Office Action dated June 24, 2005.

(5). **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baehr et al (US004880566) in view of Christiansen (US004614646) for the same rationale recited on page 6-7 in the prior Office Action dated June 24, 2005.

(6). **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baehr et al (US004880566) for the same rationale recited in the prior Office Action dated March 15, 2006.

Allowable Subject Matter

(7). **Claims 15 and 19** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

(8). Applicant's arguments filed on June 15, 2006 have been fully considered but they are not persuasive.

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Applicants assert that the stabilizer mixture of prior art reference Baehr (US004880566) is not synergistic. However, Baehr (US004880566) disclose the mixture comprising components A ~ D which meets the synergistic mixture as claimed by applicants. Applicants are suggested to provide evidence that the mixture of Baehr (US004880566) is not synergistic mixture for enhancing the brightness of bleached pulp. Mere Counsel's arguments unsupported by factual evidence are given little weight. *In re Lindner*, 457 F.2d 506, 508, 173 USPQ356, 358 (CCPA 1972).

As to the combination of Baehr (US004880566) and Christiansen (US004614646) for the 103 rejection of claim 17, Baehr (US004880566) already disclose the partially neutralized form of polyacrylic acid used in the mixture (Col. 2, line 65-66). Therefore, the disclosure of neutralized form of polyacrylic acid by Baehr (US004880566) is genus, the sodium polyacrylate of Christiansen (US004614646) is species. One of ordinary skills in the art would expect all species work well for genus, motivated by a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner: Ives Wu

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Date: August 12, 2006

DUANE SMITH
PRIMARY EXAMINER

DA
8-14-06